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In re Application of : DECISION ON
HANING et al. :
Application No.: 10/519,129 :
PCT No.: PCT/EP03/06611 : PAPERS
Int. Filing Date: 24 June 2003 :
Priority Date: 03 July 2002 : UNDER 37 CFR 1.42
Attorney's Docket No.: Le A 36 197 :
For: NOVEL USE OF IMIDAZOTRIAZINONES :

This is a decision on the submission filed by applicants on 28 September 2005, which was accompanied by, *inter alia*, a declaration of the inventors. The indication in this declaration that inventor Ulrich Niewohner is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 24 June 2003, applicants filed international application PCT/EP03/06611 which claimed a priority date of 03 July 2002 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 15 January 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 03 January 2005.

On 22 December 2004, applicants filed, *inter alia*, a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee.

On 29 July 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 28 September 2005, applicants filed the instant submission which was accompanied by, *inter alia*, a declaration of inventors and the surcharge under 37 CFR 1.492(e). The indication in

this declaration that inventor Ulrich Niewohner is deceased has been treated as a request for status under 37 CFR 1.42.

DISCUSSION

37 CFR 1.41(a)(4) states:

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis. See § 1.497(d) and (f) for filing an oath or declaration naming an inventive entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any declaration filed under PCT Rule 4.17(iv) (§ 1.48(f)(1) does not apply to an international application entering the national stage under 35 U.S.C. 371).

The declaration filed 28 September 2005 does not list the inventorship set forth in the international application. The international application identifies Maria Niewohner as an inventor while the declaration identifies her as an "heiress" rather than as an inventor. A Form PCT/IB/306 (NOTIFICATION OF THE RECORDING OF A CHANGE) from the International Bureau indicating that an inventor has been removed does not appear in the file. Nor is there any other indication that a PCT Rule 92^{bis} change has been made in the above-identified international application. Accordingly, the inventorship in the national stage is the inventorship set forth in the international application and the declaration filed 28 September 2005 is not sufficient.

The submission filed 28 September 2005 has been reviewed and would be in compliance with 37 CFR 1.42 if the above-mentioned defect were corrected as set forth below. The submission of the declaration executed by the sole heir of the deceased inventor is hereby construed as an indication that no legal representative of the deceased's estate has been appointed and that no legal representative is required by the applicable law to be appointed and thus the sole heir is signing as the legal representative of the estate. If this interpretation is incorrect, applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicants are required to file a declaration in compliance with 37 CFR 1.497(a)-(b) naming the proper inventive entity, or a proper change of inventorship under 37 CFR 1.497(d), or a Form PCT/IB/306 indicating a change effected under PCT Rule 92^{bis} corresponding to the declaration filed 28 September 2005, within TWO (2) MONTHS from the date of mailing of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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